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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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| 08/395,588      | 02/28/95    | YOSHIIA              | 1 35.C10516         |

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CHAIRMAN EXAMINER

| ART UNIT | PAPER NUMBER |
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2608

DATE MAILED:

9  
05/23/96

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/395,588

Applicant(s)

Takehiro Yoshida

Examiner

Jason Chan

Group Art Unit

2608



☒ Responsive to communication(s) filed on Mar 4, 1996

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-10 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-10 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

1. This Office action is responsive to the amendment filed 3/4/96. As directed by the amendment, claims 1 and 3 were amended and new claims 6-10 were added. Thus, claims 1-10 are presently pending in this application.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --  
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 1-4 and 6-9 are rejected under 35 U.S.C. § 102(e) as being anticipated by Roszman et al.

Roszman et al in col. 36, line 19 to col. 37 line 16, and col. 24 clearly disclose a communication apparatus which detects a telephone number of a partner station sent between call signals (during call set up) and selects one of the protocols based on the detected telephone number (note, applicant cannot rely upon the foreign priority papers to overcome this rejection because a certified translation of said papers has not been made of record. See M.P.E.P. § 201.15.).

4. Claims 1-4 and 6-9 are rejected under 35 U.S.C. § 102(e) as being anticipated by Tanake.

Tanake discloses a communication system comprising: a first detection means (2); second detection means (col. 6, lines 2-5); memory means (4) and means for reading the information (col. 6, lines 17-29, step 6) and selecting one of the plural kinds of communication protocols (the facsimile protocol, or the communication protocol for setting up voice communication).

5. Claims 1-4 and 6-9 are rejected under 35 U.S.C. § 102(e) as being anticipated by Sells et al.

Sells et al in col. 4, lines 12-27 and col. 6, lines 43-49 clearly disclose a communication apparatus which detects a telephone number (caller ID) and selects one of the communication protocols (e.g., fax application program, voice application program or data mode application program, etc).

6. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same

person or subject to an obligation of assignment to the same person.

7. Claims 5 and 10 are rejected under 35 U.S.C. § 103 as being unpatentable over Rozman et al or Tanaka or Sells et al.

The particular type of protocol used is merely a matter of design choice and an obvious modification to the apparatus of Rozman et al or Tanaka or Sells et al.

8. Claims 1-10 are rejected under 35 U.S.C. § 103 as being unpatentable over Abe et al in view of Schneyer et al.

Abe et al disclose a communication apparatus comprising means for detecting extension telephone number and selecting one of the communication protocols (different operation modes or modems) based on the detected extension telephone number.

Abe et al differ from the claimed invention in that Abe et al do not specifically disclose that number is sent between call signals. However, Schneyer teaches such (col. 5, lines 33-36). Therefore, it would have been obvious to an artisan of ordinary skill at the time of the invention to apply the teaching of Schneyers to the apparatus of Abe et al in order to allow the apparatus of Abe et al to configure the communication operation mode prior to the connection of the call.

9. Claims 1-10 are rejected under 35 U.S.C. § 103 as being unpatentable over Douglas et al in view of Tanaka or Sells et al.

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Douglas discloses a communication apparatus comprising means for detecting a telephone number (dialed number) and selecting one of the protocols (operating parameters) based on the detected number (see abstract). Douglas differs from the claimed invention in that Douglas does not specifically disclose that the telephone number is received from the partner station. However, as taught by Tanaka or Sells et al (see the rejection above), selecting a protocol based on a received number is well known in the art of telecommunication. Therefore, it would have been obvious to an artisan of ordinary skill at the time of the invention to apply the teaching of Tanaka or Sells et al to the apparatus of Douglas in order not to only allow the apparatus of Douglas to configure its operation mode based on a dialed number but to provide the additional advantage of allowing the apparatus of Douglas to also configure its operation mode based on a received number.

10. Applicant's arguments with respect to claims 1-10 have been considered but are deemed to be moot in view of the new grounds of rejection.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Chan whose telephone number is (703) 305-4729 .

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.



JASON CHAN  
PRIMARY EXAMINER  
GROUP 2600